

REMARKS

Upon entry of the present amendment claims 1-19, 21 and 24-25 are pending in the application. All claims have been amended in an effort to better define the claimed inventions. No new matter has been added. Applicants respectfully request entry of the amendments.

Amendments to, cancellation of, and additions to, the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment or cancellation of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

1. **Rejection of claims 1-17, 19-21, and 24 under 35 U.S.C. §103(a) as obvious over Neppi et al., (WO 02/44237 wherein U.S. 6,939,601 is used as English equivalent) hereafter "Neppi" or "601" in view of Hoffman et al., U.S. 5,326,820, hereafter "Hoffman" or "820".**

The basis of rejection is understood to be as follows:

[Neppi] would anticipate the claimed invention if the fluoropolymer was replaced with the polyester. ...[I]t would have been obvious to a person having ordinary skill in the prior art at the time the invention was made to have modified the clear coat material taught by Neppi by replacing the fluoropolymer with the polyester so as to obtain a clear coat composition that can be conveniently applied to a substrate in one step, wherein the modified clear coat is more environmentally friendly safer, more processible, and has good flow properties, and the resulting coatings possess both flexibility and hardness.

(Office Action of 10/30/08, pages 3-5)

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree in regards to the inventions of amended independent claim 1.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

This standard has not been met with the instant rejection.

First, Applicants and the Undersigned must strongly disagree with the basic underpinning of the PTO's rejection, i.e., [Neppi] would anticipate the claimed invention if the fluoropolymer was replaced with the polyester. Neppi does NOT anticipate the claimed invention even if "the fluoropolymer was replaced with the polyester."

Applicants' claimed invention is a curable coating composition that is applied to a substrate and cured so as to crosslink, i.e., thermosetting. As clearly demonstrated by Applicants' Specification and working examples, the claimed coating composition is a single composition that is applied to a substrate at one time and cured at one time.

In contrast, Neppi discloses two separate coat layers, an intermediate coat layer and a top-coat layer, that together make up the clear coat layer. Neppi expressly teaches that each layer is separately applied and crosslinked. (*Col. 2, ll. 66-Col. 3, ll. 8 and Col. 3, ll. 31-46.*) Thus, Neppi teaches two separate and distinct coating compositions that comprise a particular combination of components. For example, Neppi's intermediate coat layer is made up of a cycolaliphatic hydroxyl functional polyester (A) and a blocked polyisocyanate (B). Neppi's top-coat layer however, is made up of a hydroxyl functional acrylate (A), a fluoropolymer (B), and a blocked isocyananate (C), which is preferably taught to be a blocked isophorone diisocyanate.

Nothing in Neppi teaches or suggests that these five components ((A), (B), (C)) and ((A), (B)) required in Neppi's two separate and distinct coatings can be combined into a single coating composition that can be applied and cured in a single step. Rather, Neppi expressly teaches away from any such interpretation at col. 3, ll. 31-46. Neppi expressly indicates that the two separate coat layers provide advantages over a "double clear coat layer" which Neppi describes as "in which two layers have been produced from the same coating".

Indeed, Neppi expressly teaches that the use of the two separate layers for the clearcoat, i.e., the intermediate layer and the top-coat layer provide important functional advantages over prior art single layer clear coats. For example, Neppi particularly indicates that both intercoat and substrate adhesion is improved with the use of two separate and distinct coating compositions that are separately applied and cured. Neppi also teaches that the intermediate coat layer must have a different flexibility than the top-coat layer.

The PTO has failed to provide any motivation or rationale to suggest why one of skill in the art would seek to combine Neppi's two separate and distinct coating compositions (that are separately applied and cured) into single composition that is applied at one time and cured at one time. To do so would be in contravention of the overall focus and teaching of Neppi, i.e., see Neppi's col. 3, ll. 31-46, and would change the fundamental principle of operation of Neppi, i.e., a two layer clear coat instead of a single layer clear coat. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 123 U.S.P.Q. 349 (CCPA 1959); MPEP 2143.01.

Clarification of the PTO's reliance upon Neppi's working example is also requested. The Undersigned's review of the Vestanat B 1370 information data sheet failed to show any indication that it is an isophorone based diisocyanate.

Moreover, the Undersigned's calculation indicates that Neppi's top-coat uses more acrylic than allowed in Applicants' claimed invention: acrylic copolymer 44% by weight; fluoropolymer 17% by weight; Desmodur® BL 3175 18% by weight; Vestanat® B 1370 21% by weight, all % by weight based on (A), (B), (C), and (C). The PTO has failed to suggest why one of skill in the art would modify this example so as to do what Applicants have done.

Finally, the Undersigned notes that the PTO's statement that Neppi "...teaches a process of coating using the disclosed clear coat material and curing at 249°C (col. 13, lines 47-60)" is erroneous. For example, col. 13, ll. 47-51 refers only to the curing and crosslinking of the intermediate coat layer. The immediately following paragraph continues on to discuss the separate application and curing of the top-coat layer of the disclosed clear coat, i.e., at col. 13, ll. 52-55.

Hoffman is relied upon to correct the deficiencies of Neppi. However, the PTO only relies upon Hoffman to replace the fluoropolymer of Neppi's top-coat layer with Hoffman's polyester. Even if such were to occur, this combination does not result in the coating composition of Applicants' claim 1.

First, Hoffman does not teach the use of a polyester equivalent to Applicants' component (B) that has from 30 to 70 % by weight of cycloaliphatic structural units. The PTO attempts to say that Hoffman teaches that the cycloaliphatic content is from 5-100 mole% (col. 2, lines 30-40; col. 3, lines 28-33; col. 5, lines 64-68). However, what these sections say is that the polyester (A1) is made from components a), b), c), and d) wherein component a) is a polycarboxylic acid component. The relied upon sections of Hoffman merely state that 5-100 mole% of the carboxylic acid component employed be cycloaliphatic. Hoffman does not however, state how much of component a) be employed in making the polyester (A1). As a result, one of skill in the art cannot know the weight % of structural cycloaliphatic units desired or intended. Where the prior art gives no indication of which parameters are critical and no direction as to which of many possible choices is likely to be successful, the fact that the claimed combination falls within the scope of possible combinations taught therein does not render it unpatentably obvious. *In re O'Farrell*, 7 U.S.P.Q 1673 (Fed. Cir. 1988).

Most importantly, the PTO has failed to suggest why, after modifying Neppi's top-coat material, one of skill in the art would then seek to use that material alone as a clear coat. That is, the PTO has failed to explain why one of skill in the art would completely ignore the rest of the principle reference's teachings. If proposed modifications would render the prior art invention being modified unsatisfactorily for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gorden*, 221 U.P.S.Q. 1125 (Fed. Cir. 1984); MPEP 2143.01.

For example, the Federal Circuit has clearly stated that "each prior art reference must be evaluated as an entirety, and ...all of the prior art must be evaluated as a whole". *In re Fritch*, 23 U.S.P.Q.2d 1780, 1782 (Fed. Cir. 1992). And particularly on point, the CCPA had earlier said "[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined

teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 108 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

Finally, this combination lacks any disclosure of Applicants' particular combination of blocked polyisocyanates, i.e., Applicants' blocked polyisocyanate (C) and blocked polyisocyanate (D). As noted above, clarification has been requested.

As indicated in Applicants' new claim 25, Applicants' method of coating a substrate requires that the composition of claim 1 be the only clear coat employed therein.

Taken as a whole, it is respectfully submitted that the cited combination fails to provide the requisite motivation for a *prima facie* case of obviousness.

Reconsideration and removal of the obviousness rejection of independent claim 1 and all claims dependent thereon is respectfully requested in view of the foregoing remarks.

2. **Rejection of claim 18 under 35 U.S.C. §103(a) as obvious over Neppi et al., (WO 02/44237 wherein U.S. 6,939,601 is used as English equivalent) hereafter "Neppi" or "601" in view of Hoffman et al., U.S. 5,326,820, hereafter "Hoffman" or "820" and O'Connor et al., U.S. 5,521,272, hereafter "O'Connor" or "272".**

The foregoing Section 1 is incorporated herein by reference. Claim 18 is dependent upon claim 1. O'Connor is relied upon solely for the disclosure of pyrazole as an isocyanate blocking agent. As such it fails to rectify the above noted deficiencies of the principal reference.

Accordingly, it is submitted that independent claim 1 and all claims dependent thereon, including 18 are novel.

Reconsideration and removal of the rejection is respectfully requested.

CONCLUSION

Applicant(s) respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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